

REMARKS

Claims 2 through 15, 17 through 21 and 23 through 30 are pending in this application. Claims 2, 17, 23, 27 and 30 are the independent claims. The Examiner has rejected claims 1 through 9 and 12 through 30 under 35 U.S.C. § 102(b). The Examiner has rejected claims 10 and 11 under 35 U.S.C. § 103.

Claims 1, 16 and 22 have been cancelled without prejudice or disclaimer.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1 through 9 and 12 through 30 were rejected under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 5,526,520 to Krause. This rejection is respectfully traversed.

Although independent claim 1 has been canceled, the subject matter contained therein, and which was already included in claim 2, has been incorporated into claim 2 to rewrite claim 2 in independent form. Therefore, it is appropriate to address the Examiner's rejections of claims 1 and 2 relative to claim 2.

Regarding claim 1, the Examiner stated that "Krause discloses . . . determining if said primary document includes an indicator; and identifying said secondary document if said primary document includes said indicator [col 9 line 28 - col 10 line 5]." Regarding claim 2, the Examiner also stated that "Krause discloses attaching said secondary document to said primary document if said primary document includes said indicator [col 10 lines 6-27]." Applicant respectfully disagrees.

The Krause patent deals only with "storing a primary document" and "storing a secondary document" and has nothing to do with "determining if said primary document includes an indicator;

identifying said secondary document if said primary document includes said indicator; and attaching said secondary document to said primary document if said primary document includes said indicator,” as recited in claim 2. Specifically, nothing in the Krause patent discloses “determining” if an indicator is included in the primary document and then “identifying” the secondary document as a result of the mere presence of the indicator. In fact, “identifying” the secondary document only occurs when a “hotspot” on the primary document, which provides a link to the secondary document, is selected/activated by a user. Likewise, although the Krause patent discloses linking the “hotspot” on the primary document with “a frame file” of the secondary document (column 10, lines 9 through 27) and displaying the frame file upon “activation” of the hotspot, the secondary document is never attached to the primary document as in claim 2. At best, the secondary document is referenced by a hotspot on the primary document and is only displayed after a user has selected/activated the hotspot. In contrast, the mere presence of an indicator in the primary document causes the method of claim 2 to identify the secondary document and then attach the secondary document to the primary document without any user selection/activation of the indicator. Therefore, nothing in the Krause patent teaches or suggests “determining if said primary document includes an indicator; identifying said secondary document if said primary document includes said indicator; and attaching said secondary document to said primary document if said primary document includes said indicator,” as recited in claim 2. Accordingly, the Krause patent fails to anticipate the method recited in claim 2 and claims 3 through 15 that depend therefrom.

For at least the same reasons stated above for claim 2, the rejection of independent claims 17, 23, 27 and 30, of which claims 17 and 23 have been rewritten in independent form similar to

claim 2, and the claims that depend respectively therefrom, under 35 U.S.C. § 102(b) is improper. Therefore, it is respectfully requested that this rejection also be withdrawn.

Accordingly, the withdrawal of the Section 102 rejection of claims 2 through 15, 17 through 21 and 23 through 30, and the issuance of a notice of allowance is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 10 and 11 were rejected under 35 U.S.C. § 103(a), as being unpatentable over the Krause patent in view of U.S. Patent No. 6,073,165 to Narasimhan et al.. These rejections are respectfully traversed.

For at least the same reasons stated above for claim 2, the rejection of claims 10 and 11 under 35 U.S.C. §103 is improper, and it is respectfully requested that this rejection be withdrawn and a notice of allowance to that effect be issued.

CONCLUSION

In view of the above remarks, the Applicants respectfully submit that the present case is in condition for allowance and again respectfully request that the Examiner issue a notice of allowance.

The undersigned does not believe any fee is due in conjunction with this Amendment/Response. However, the Office is hereby authorized to charge any fees deemed necessary under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon Deposit Account No. 11-0600.

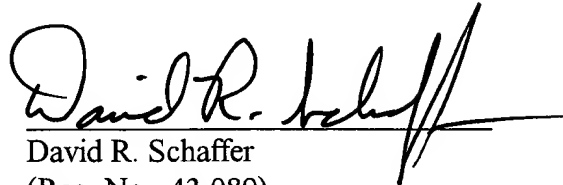
The Examiner is invited to contact the undersigned at (202) 220-4263 to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON

Dated: 26 November 2001

By:


David R. Schaffer
(Reg. No. 43,089)

1500 K Street., N.W.
Suite 700
Washington, D.C. 20005
Tel: (202) 220-4200
Fax: (202) 220-4201

MARK-UP VERSION OF AMENDMENTS

IN THE CLAIMS:

Please amend the claims as follows:

2. (Amended) [The] A method [according to claim 1, further comprising] for identifying a secondary document relative to a primary document comprising:

determining if said primary document includes an indicator;

identifying said secondary document if said primary document includes said indicator;

and

attaching said secondary document to said primary document if said primary document includes said indicator.

8. (Amended) The method according to claim [1] 2, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.

sub-c37
9. (Amended) The method according to claim [1] 2, wherein determining if said [at least one word] primary document includes [one of] said indicator is performed using syntactic processing.

11. (Amended) The method according to claim [12] 10, further comprising sending said e-mail message and said secondary document attached thereto to a recipient via a communications device.

13. (Amended) The method according to claim 2, further comprising sending said primary document and said secondary document attached thereto to a recipient via facsimile.

15. (Amended) The method according to claim [1] 2, further comprising adding at least one additional indicator to said indicator as a function of a user input.

17. (Amended) [The system according to claim 16, wherein said processor attaches] A system for identifying a secondary document related to a primary document comprising:
a first storage device storing said primary document;
a second storage device storing said secondary document;
a third storage device storing an indicator; and
a processor coupled to said first storage device, said second storage device and said third storage device, said processor determining if said primary document includes said indicator, identifying said secondary document if said primary document includes said indicator, attaching said secondary document to said primary document if said primary document includes said indicator.

18. (Amended) The system according to claim [16] 17, wherein said secondary document has a filename and a location, wherein said primary document includes at least one word, and wherein said processor determines at least one of said filename and said location of said secondary document as a function of at least one of a user input and said at least one word.

20. (Amended) The system according to claim [16] 17, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.

21. (Amended) The system according to claim [16] 17, wherein said processor determines if said primary document includes said indicator using syntactic processing.

23. (Amended) [The system according to claim 22, wherein said processor attaches] A system comprising:
a storage device;
a set of instructions stored on the storage device; and

a processor executing said set of instructions to identify a secondary document relative to a primary document by:

determining if said primary document includes an indicator,
identifying said secondary document if said primary document includes said
indicator, and
attaching said secondary document to said primary document if said primary document includes said indicator.

24. (Amended) The system according to claim [22] 23, wherein said secondary document has a filename and a location, wherein said primary document includes at least one word, and wherein said processor determines at least one of said filename and said location of said secondary document as a function of at least one of a user input and said at least one word.

25. (Amended) The system according to claim [22] 23, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.

26. (Amended) The system according to claim [22] 23, wherein [said processor determines if] said processor determines if said primary document includes said indicator using syntactic processing.

27. (Amended) A method for identifying an address of a recipient of a primary document comprising:

determining if said primary document includes an indicator; [and]
identifying said address of said recipient if said primary document includes said [indicator.] indicator, and
attaching said address of said recipient to said list of said at least one address if said
primary document includes said indicator.